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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,778	08/24/2001	Nikhil M. Deshpande	884.491US1	2935
21186	7590	06/13/2005	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402-0938				JAMAL, ALEXANDER
ART UNIT		PAPER NUMBER		
2643				

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/938,778	DESHPANDE ET AL.
	Examiner Alexander Jamal	Art Unit 2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 3-30-2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-29 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-29 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Response to Amendment

1. Examiner notes that only arguments have been submitted. All prior standing claim rejections are maintained below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1,2,14-16, 21-22** rejected under 35 U.S.C. 102(e) as being anticipated by Waites (6788769).

As per **claim 1**, Waites discloses a communication system that may comprise an IM system (Col 1 lines 10-20). The system comprises an origin device where a user is able to input text or speech (Col 3 lines 29-46) or convert input speech to text in order to be transmitted (Col 9 lines 36-50).

As per **claim 14**, claim rejected for same reasons as rejection of claim 1.

Additionally, Waites' originating device inherently comprises a controller to determine whether a speech option is selected for the purpose of being able to correctly coordinate the operation of the IM server interface and the speech-to-text converter.

As per **claim 21**, claim rejected for same reasons as rejection of claim 19. The terminals inherently comprise software on a signal bearing medium for the purpose of controlling the terminal hardware.

As per **claims 2,22** claims rejected for same reasons as claim 1,21 rejections.

As per **claim 15**, when the IM transmitted, it will be sent/received across a long-lived connection (the interface between the sending terminal and the network connected to the IM server).

As per **claim 16**, the IM server will pass along an IM to the destination device.

4. Claims 6-10,12 rejected under 35 U.S.C. 102(e) as being anticipated by Andrews et al (6522878).

As per **claims 6,7**, Andrews discloses a method comprising receiving an instant message (alphanumeric page) comprising text at a destination device, then converting

that text into speech if the speech option is selected (pager mode announce) (Col 4 lines 12-22).

As per **claims 10,8**, claims rejected for same reasons as claim 6. Additionally, Andrews' method will receive and convert the text independently of the manner in which the sender of the page input the text.

As per **claims 9,12**, when the page is transmitted and received via the cellular network, the pages will be sent/received across a long-lived connection (the interface between the cellular access point and the cellular network).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 3-5,18,23-25** rejected under 35 U.S.C. 103(a) as being unpatentable over Waites et al. (6788769) as applied to claims 1,2,14,21,22, and further in view of Andrews (6522878).

As per **claim 3**, Waites discloses applicant's claims 1,2,14,21,22, but does not specify that the receiving pager comprise a speech option to convert incoming text into speech.

Andrews discloses a pager with a text-to-speech converter (Col 4 lines 10-20). He also teaches that a text-to-speech interface may provide the user a more efficient way of receiving text messages (Col 1 lines 30-40). It would have been obvious to one of ordinary skill in the art at the time of this application that the receiving pager of Waites' system could comprise a text-to-speech converter for the advantage of providing a user with an additional interface (hearing) to communicate with.

As per **claim 4**, claim rejected for same reasons as claim 3 rejection.

As per **claims 5,25**, the message delivery interface at the receiving device is independent of the message inputting interface at the sending device.

As per **claims 18,23,24**, claim rejected for same reasons as claim 3 rejection.

7. **Claims 19,20,26-29**, rejected under 35 U.S.C. 103(a) as being unpatentable over Waites et al. (6788769), and further in view of Andrews (6522878).

As per **claim 19**, Waites discloses an IM system as per the claim 1 rejection. However, Waites does not disclose the destination client device comprising a text-speech converter to convert the received messages into speech.

Andrews discloses a pager with a text-to-speech converter (Col 4 lines 10-20).

He also teaches that a text-to-speech interface may provide the user a more efficient way of receiving text messages (Col 1 lines 30-40) independently of how they were sent. It would have been obvious to one of ordinary skill in the art at the time of this application that the receiving pager of Waites' system could comprise a text-to-speech converter for the advantage of providing a user with an additional interface (hearing) to communicate with.

As per **claim 26**, claim rejected for same reasons as rejection of claim 19.

As per **claim 20**, claim rejected for same reasons as claim 19.

As per **claim 27**, claim rejected for same reasons as claim 1.

As per **claim 28**, claim rejected for same reasons as claim 15.

As per **claim 29**, Waites discloses that the message may be sent as an email message (request-reply pair) (Col 1 lines 14-20).

8. **Claim 17** rejected under 35 U.S.C. 103(a) as being unpatentable over Waites et al. (6788769) as applied to claim 14, and further in view of Ogle et al. (6430604).

As per **claim 17**, Waites discloses applicant's claim 14, but does not specify that the IM server drops the messages when no destination client device is connected.

Ogle discloses an IM system in which the messages may be dropped if the receiving device is not available (Col 3 lines 20-35). It would have been obvious to one of ordinary skill in the art at the time of this application that an IM server could drop a message if the receiving device were not connected for the reason that the server not get overloaded with undelivered messages.

9. **Claims 11,13** rejected under 35 U.S.C. 103(a) as being unpatentable over Andrews et al (6522878) as applied to claim 10, and further in view of Waites (6788769).

As per defendant **claim 11**, Andrews discloses applicant's claim 10 but does not disclose determining whether a speech option is chosen at the origin (sender) device and when selected, converting input speech to text.

Waites discloses a communications system that may comprise instant messaging (paging) (Col 1 lines 10-20). He discloses that the user may be able to dictate a voice message that is sent through a speech-to-text converter (Col 9 lines 35-51). It would have been obvious to one of ordinary skill in the art at the time of this application that the sending device could comprise a speech-to-text converter for the purpose of providing an additional interface for the sender (ie. the sender may dictate a voice message that may be sent to a receiving pager).

As per **claim 13**, Waites discloses that the message may be sent as an email message (request-reply pair) (Col 1 lines 14-20).

10. Applicant's arguments filed 3-30-2005 have been fully considered but they are not persuasive.

As per applicant's argument that Waites does not disclose transmitting an instant message (remarks page 7), Waites discloses that the directory messaging system may be used with an instant messaging system (Col 2 lines 55-65).

As per applicant's argument that the 'instant messaging' referred to by Waites is a 'broad reference to the field of electronic communications' (remarks page 8), examiner respectfully disagrees. Waites discloses 'instant messaging' as a 'diverse communication mechanism' (Col 2 lines 55-65), which is not a 'broad reference to the field of electronic communications'.

As per applicant's argument that the system of Waites does not inherently comprise a 'controller' (remarks page 9) or software in the communication terminals. Examiner reads a controller as any means to perform the disclosed functions of the disclosed terminals in Waites (Col 9 lines 35-50). Additionally, examiner maintains that all modern (at filing date of this application) digital communications terminals inherently comprise software for the purpose of controlling the hardware for it's intended function. Additional support for the use of software is disclosed in (Col 9 lines 35-50).

As applicant's arguments that Andrews does not disclose an instant message (remarks page 10), examiner reads an 'instant message' as a page signal and as such, it is disclosed by Andrews.

As per applicant's argument that there is insufficient motivation to combine Andrews with Waites (Remarks pages 10-13), examiner maintains that providing an additional (and well known) user interface to the terminals disclosed by Waites user is sufficient motivation to combine the references.

As per applicant's argument that there is insufficient motivation to combine Ogle with Waites (Remarks pages 12-13), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, examiner contends that it would have been obvious to one skilled in the art at the time of the application that an infinite number of messages could not be stored on a server of limited storage capacity. As such, a system that could potentially get an unlimited number of message requests comprises an inherent need to manage the incoming messages in a manner that keeps the system functioning. If unlimited messages were allowed to accrue then the system would cease to function when all available storage space was used up.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Jamal whose telephone number is 571-272-7498. The examiner can normally be reached on M-F 9AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A Kuntz can be reached on 571-272-7499. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9315 for After Final communications.

AJ
June 6, 2005


CURTIS KUNTZ
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